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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/521,982

12/08/2005

Peter Gallagher

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EXAMINER

MAEWALL, SNIGDHA

ART UNIT

PAPER NUMBER

1612

MAIL DATE

DELIVERY MODE

02/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/521,982	Applicant(s) GALLAGHER ET AL.	
	Examiner Snigdha Maewall	Art Unit 1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Summary

1. Receipt of Applicant's Arguments/Remarks, amended claims and RCE filed on 10/09/08 is acknowledged.

Claims 6 and 9-10 have been cancelled. Claims 1, 2, 4, 5 and 7 have been amended. Accordingly, claims **1-5 and 7** are under prosecution.

The rejections not reiterated in this office action have been withdrawn in view of Applicant's arguments and amendments to the claims.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-5 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites the limitation "vinyl polymer". Claim 5 recites the limitation "block copolymer". The claims lack structural limitations. In

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the absence of appropriate and specific structural limitations, the phrase “vinyl polymer” will read on any polymer. Appropriate recitation of specific component is requested in order to deduce structural and functional relationship of the claimed composition. Applicant has not shown possession of all the vinyl polymer or block copolymer that exists in treating hair.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See, e.g., In re Wilder, 22 USPQ 369, 372-3 (Fed. Cir. 1984). (Holding that a claim was not adequately described because the specification did ‘little more than outline goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate.’)

Mere indistinct terms (such as vinyl polymer or block copolymer used herein), however, may not suffice to meet the written description requirement. This is particularly true when a compound is claimed in purely functional terms. See Univ. of Rochester v. G.D. Searle, 69 USPQ2d 1886 (CAFC 2004) at 1892, stating:

The appearance of mere indistinct words in a specification or a claim, even an original claim, does not necessarily satisfy that requirement. A description of an anti-inflammatory steroid, i.e., a steroid (a generic structural term) described even in terms of its functioning of lessening inflammation of tissues fails to distinguish any steroid from others having the same activity or function. A description of what a material does, rather than of what it is, usually does not suffice.... The disclosure must allow one skilled in the art to visualize or recognize the identity of the subject matter purportedly described. (Emphasis added).

Conversely, a description of a chemical genus will usually comprise a recitation of structural features common to the members of the genus, which features constitute a substantial portion of the genus. See Univ. of Cal. V. Eli Lilly, 43 USPQ 2d 1398, 1406

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(Fed. Cir. 1997). This is analogous to enablement of a genus under Section 112, ¶ 1, by showing the enablement of a representative number of species within the genus.

A chemical genus can be adequately described if the disclosure presents a sufficient number of representative species that encompass the genus. *If the genus has substantial variance, the disclosure must describe a sufficient number of species to reflect the variation within that genus.* See MPEP 2163. The MPEP lists factors that can be used to determine if sufficient evidence of possession has been furnished in the disclosure of the Application. These include the level of skill and knowledge in the art, partial structure, physical and/or chemical properties, functional characteristics alone or coupled with a known or disclosed correlation between structure and function, and the method of making the claimed invention. Disclosure of any *combination of such identifying characteristics that distinguish the claimed invention from other materials* and would lead one of skill in the art to the conclusion that the applicant was in possession of the claimed species is sufficient. MPEP 2163.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation styling polymer and the claim also recites vinylic polymer which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 1-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakuta (US Patent no. 6,984,390).

Sakuta discloses cosmetic preparations. The composition disclosed is used for shampoo, conditioner, hair coloring agents, hair tonic and cosmetic materials etc.(see paragraph [0075]. 2-hydroxyoctanoic acid is disclosed in example 21 and 22. vinyl polymers and block copolymers are disclosed in paragraph [0029] and [0062]. With respect to the composition being a leave on product, it is the position of the examiner that claims are given broadest reasonable interpretation during prosecution, Sakuta teaches shampoo which reads on leave on product specially in the absence of specific duration recited in claims with respect to leave on product. Furthermore, the limitation of the composition being a leave on product is an intended use, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, and then it meets the claim.

Response to Arguments

8. Applicant's arguments filed 10/09/08 have been fully considered but they are not persuasive.

Applicants argue that Sakuta is directed to cosmetic materials that contain sterol-modified silicone and the examples are directed to transparent gel and sunscreen toilet.

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None of these examples include vinylic styling polymer and 2-hydroxyalacanoic acid.

None of the references describe the disclosure of benefits of such a combination in terms of providing a composition with improved high humidity hold or a method of styling.

Applicants arguments are not persuasive because applicant is arguing an additional ingredient such as sterol-modified silicone which is also taught in the prior art. In response to this argument, the Examiner respectfully points out that the open-ended "comprising language of the claims do not preclude reading any other embodiment, component or compounds in the claims. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (a styling polymer to provide a leave-on styling product having improved high humidity hold) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With respect to the composition being a leave on product, it is the position of the examiner that claims are given broadest reasonable interpretation during prosecution, Sakuta teaches shampoo and conditioner which read on leave on product specially in the absence of specific duration recited in claims with respect to leave on product.

The following rejection is a new rejection based on Applicants amendments to the claims.

9. Claims 1-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over GALLAGHER et al (EP 0424158, presented in IDS) in view of Sakuta (US Patent no. 6,984,390).

GALLAGHER teaches a method of styling hair by applying to the hair a hair treatment mousse (see pg. 3, line 31) comprising: 1% of 2-hydroxyalkanoic acid, such as 2-hydroxyalkanoic acid (see pg. 1, line 45-51; and pg. 6, Example 4); less than 2% of a surfactant (see pg. 6, Example 4); a styling polymer (see pg. 3, line 34); and perfume (see pg. 3, line 47). 2-hydroxyoctanoic acid is disclosed on page 2, lines 10-14.

Gallaher does not explicitly teach vinylic polymer or block copolymer.

Sakuta discloses cosmetic preparations. The composition disclosed is used for shampoo, conditioner, hair coloring agents, hair tonic and cosmetic materials etc.(see paragraph [0075]. 2-hydroxyoctanoic acid is disclosed in example 21 and 22. vinyl polymers and block copolymers are disclosed in paragraph [0029] and [0062].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate vinylic and block copolymer in the composition of Gallaher et al. with a reasonable expectation of success because Gallaher teaches adding styling polymer and Sakuta teaches adding vinylic and block copolymer in preparing shampoo, conditioner etc. along with 2-hydroxyalkanoic acids.

The references do not specifically teach adding the ingredients in the amounts claimed by Applicant. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely

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optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ and reasonably would expect success. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of Applicant's invention.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Snigdha Maewall whose telephone number is (571)-272-6197. The examiner can normally be reached on Monday to Friday; 8:30 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-0580. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

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Customer Service Representative or access to the automated information system, call
800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Snigdha Maewall/

Examiner, Art Unit 1612

/Gollamudi S Kishore /

Primary Examiner, Art Unit 1612